

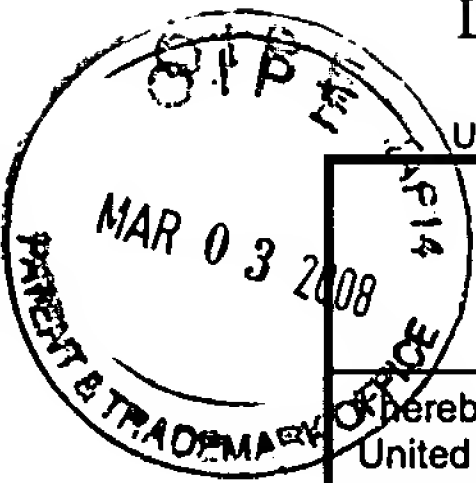
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

944-006.006-1

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on February 28, 2008

Signature Kathleen Sipos

Typed or printed name Kathleen Sipos

Application Number

09/867,049

Filed

May 29, 2001

First Named Inventor

Kai NYMAN

Art Unit

2137

Examiner

Zachary A. Davis

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 58,051

Keith R. Obert

Signature

Keith R. Obert

Typed or printed name

203-261-1234

Telephone number

February 28, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Attorney Docket No. 944-006.006-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

Kai NYMAN

: Confirmation No. **7666**

Serial No.: **09/867,049**

: Examiner: **Zachary A. Davis**

Filed: **May 29, 2001**

: Group Art Unit: **2137**

For: **AUTHENTICATION IN DATA COMMUNICATION**

Mail Stop AF
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the final Office Action of October 30, 2007, please reconsider the rejections in view of the following remarks:

CERTIFICATE OF MAILING

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Kathleen Sipos

Dated: 28 February 2008

REMARKS

Claims 1-14, 25-31, 35 and 37-56 were examined by the Office, and in the final Office Action of October 30, 2007 all claims are rejected. Applicant respectfully submits that the Office has committed clear error in rejecting the claims for at least the reasons set forth below. Accordingly, applicant respectfully requests reconsideration and withdrawal of the rejections.

This response is submitted along with a Notice of Appeal.

Claim Rejections Under § 103

In section 4, on page 5 of the Office Action, claims 1-10, 13-14, 25-31, 35, 37-47 and 50-56 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berggren (WO 00/44130) in view of Turtiainen (U.S. Patent No. 6,430,407) and Bilgic et al. (U.S. Patent no. 6,097,817).

Applicant respectfully submits that claim 1 is not disclosed or suggested by the cited references, alone or in combination, because the cited references fail to disclose or suggest all of the limitations recited in claim 1. Claim 1 is amended to clarify that a mobile client receives a subscriber identity sent from a mobile station, and the subscriber identity corresponds to a subscriber of a mobile telecommunication network. Applicant respectfully submits that the cited references, alone or in combination, at least fail to disclose or suggest receiving at a mobile client a subscriber identity sent from a mobile station where the mobile client is separate from the mobile station, as recited in claim 1.

In contrast to claim 1, Berggren only discloses that the subscriber identity is received from a SIM card (160), and not a mobile station. The Office asserts that since the SIM card is part of the mobile station, then the subscriber identity must also be received from the mobile station. However, the SIM card (160) may be inserted to a SIM card reader (261) or the mobile terminal, and therefore since the SIM card (160) may provide the identity through the SIM card reader (261) to a terminal (262) without use of the mobile terminal it indicates that the subscriber identity is sent from the SIM card and not the mobile station as recited in claim 1. In contrast to Berggren, in the present invention the mobile client receives the subscriber identity directly from the mobile station without the need of removing the SIM card from the mobile phone and inserting it into a SIM card reader coupled to the terminal. Furthermore, the SIM card reader (261) is merely an accessory device to the terminal (262) and is only useful when it is coupled to the terminal. In contrast, in claim 1 the mobile station is an independent device from the mobile

client. Therefore, Berggren at least fails to disclose or suggest receiving at the mobile client the subscriber identity sent from the mobile station, wherein the mobile station is separate from the mobile client as recited in claim 1.

Furthermore, Turtiainen fails to make up for the deficiencies in the teachings of Berggren, because Turtiainen also fails to disclose or suggest receiving at a mobile client a subscriber identity sent from a mobile station. While applicant acknowledges that Turtiainen discusses that the mobile station (1) and user interface (16) may directly communicate with each other through a suitable operational connection, Turtiainen never discloses or suggests that the subscriber identity is ever sent to the user interface (16), whether input by the user or through an operational connection. Instead, Turtiainen only discloses that transactions can be acknowledged by sending the details of the transaction to the MS PAD (35) to ensure correctness by means of a checksum calculated by the MS PAD (35) in accordance with a predefined algorithm and utilizing the secret of the SIM (34). See Turtiainen column 9, lines 59-65. The checksum has to match with the sum displayed by the user terminal (16). However, the sum displayed by the user terminal (16) is transmitted by the application to the user terminal, and is not provided by the mobile station (1), either directly or through user input. See Turtiainen column 8, lines 60-65 (application retrieves user related authentication data from an appropriate database and sends a text message to the mobile station). Therefore, Turtiainen also fails to disclose or suggest receiving at the mobile client the subscriber identity sent from the mobile station, as recited in claim 1.

Furthermore, applicant respectfully submits that the motivation offered by the Office to combine the teachings of Berggren and Turtiainen is insufficient. The Office asserts that inclusion of the features from Turtiainen is motivated by freeing a user from using a separate authentication device. However, Turtiainen itself solves the problem used as the motivation by the Office by using a mobile phone as an authentication aid in a similar manner as an embodiment of Berggren. Therefore, since each reference alone provides a sufficient solution for using a mobile phone and/or SIM authentication the motivation offered by the Office to combine Berggren and Turtiainen is insufficient. As such, there is no motivation to combine the cited references, and as discussed above, even if the references were combined the subject matter of claim 1 would not be produced.

Bilgic does not make up for the deficiencies identified above with respect to the teachings of Berggren and Turtiainen. Therefore, since the cited references individually fail to disclose or suggest all of the limitations recited in claim 1, it necessarily follows that even if the references are combined they will also fail to disclose or suggest all of the limitations recited in claim 1. Instead, Bilgic is directed to a communication system having a wireless trunk for connecting multiple phone lines over wireless communication links to a cellular network that includes a central telephone switch connected through one or more trunk lines to a wireless access communication unit. Bilgic does not disclose or suggest receiving at a mobile client a subscriber identity sent from a mobile station, where the mobile station is separate from the mobile client, as recited in claim 1. Therefore, Bilgic fails to make up for the deficiencies recited in claim 1, and the cited references, alone or in combination, fail to disclose or suggest all of the limitations recited in claim 1. See MPEP § 2143.03.

Furthermore, the Office states that inclusion of the teachings of Bilgic is motivated by further providing authentication and security in a mobile wireless communication system. Bilgic discloses a GSM gateway type wireless access device, e.g. a PABX, for connecting to a GSM network. The PABX is connected to the wireless access device by trunk lines, and each trunk corresponds to a subscription in the GSM network, having an associated SIM. Each trunk is authenticated to the GSM network by a respective SIM using standard GSM authentication. Therefore, Bilgic discloses authentication to a GSM network using GSM authentication, which is inherently present in both Berggren and Turtiainen, since the mobile stations of Berggren and Turtiainen are communicating with a mobile communication network. As such, there is no need to add further authentication to the teachings of Berggren and Turtiainen. Therefore, for at least this additional reason, claim 1 is not disclosed or suggested by the cited references.

Independent claims 13, 25, 30, 35, 37, 38 and 50 all contain limitations similar to those recited in claim 1, and are rejected for the same reasons as claim 1. Therefore, for at least the reasons discussed above in relation to claim 1, claims 13, 25, 30, 35 37, 38 and 50 are not disclosed or suggested by the cited references, alone or in combination, and applicant respectfully requests withdrawal of the rejections to these claims.

Claims 2-10, 14, 26-29, 31, 39-47 and 51-56 all ultimately depend from an independent claim, and are patentable over the cited references at least in view of their dependencies.

In section 5, on page 10 of the Office Action, claims 11-12 and 48-49 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berggren in view of Turtiainen and Bilgic, and in further view of Lightman (U.S. Patent No. 6,711,414). Claims 11-12 and 48-49 ultimately depend from an independent claim, and are patentable over the cited references at least in view of their dependencies.

Conclusion

For at least the forgoing reasons, applicant respectfully submits that the application is in condition for allowance, and such action is earnestly solicited. The undersigned hereby authorizes the Commissioner to charge any fee deficiency required to submit this response to Deposit Account No. 23-0442.

Respectfully submitted,

Date: 28 February 2008



Keith R. Obert
Attorney for the Applicant
Registration No. 58,051

WARE, FRESSOLA, VAN DER SLUYS
& ADOLPHSON LLP
755 Main Street, P.O. Box 224
Monroe, CT 06468
Telephone: (203) 261-1234
Facsimile: (203) 261-5676
Customer No. 004955